

**V. REMARKS**

Entry of the Amendment is proper under 37 C.F.R. §1.116 because the Amendment: a) places the application in condition for allowance for the reasons discussed herein; b) does not raise any new issue requiring further search and/or consideration because the Amendment amplifies issues previously discussed throughout prosecution; c) does not present any additional claims without canceling a corresponding number of finally rejected claims; and d) places the application in better form for appeal, should an Appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. The amendments to the subject claims do not incorporate any new subject matter into the claims. Thus, entry of the Amendment is respectfully requested.

Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement alleging that the claims contained subject matter which was not described in the specification to enable one of ordinary skill in the art to make and/or use the invention. In one instance, the Office Action asserts that there is no description in the disclosure explaining how a laminate of a pressured sensitive adhesive layer and the transfer mark layer can have adhesive forces from both a pressure sensitive adhesive layer to a base tape and also the mark array layer to the base tape commenting that it does not appear to be geometrically possible.

It is respectfully submitted that the reference numerals for the constituent components of the claimed invention as follows:

- 15 - base tape
- 16 - transfer mark layer
- 17 - surface forming layer
- 18 - mark array layer
- 19 - pressure-sensitive adhesive layer

as shown in Figs. 5B, 5C, 6, 17B and 17C.

As claimed in claims 1 and 21, by way of example only in Figs. 5B and 5C, the transfer mark layer (16) is formed by integrally laminating at least a pressure-sensitive adhesive layer (19) and a mark array layer (18). In Figs. 5B and 5C by way of example only but not claimed in claims 1 and 21, the transfer mark layer (16) also includes a surface forming layer (17).

Claims 1 and 21 recite that the adhesive force PA of the pressure-sensitive adhesive layer (19) on the transfer area, the adhesive force PC of the transfer mark layer (16) and base tape (15), and the adhesive force PD of the pressure-sensitive adhesive layer (19) and base tape (15) are set in the relation of  $PA \geq PC \geq PD$ .

It is respectfully submitted that the first issue is whether there is a description in the disclosure explaining how a laminate of a pressured sensitive adhesive layer (19) and the transfer mark layer (16) can have adhesive forces from both a pressured sensitive adhesive layer (19) to a base tape (15) and also the mark array layer (18) to the base tape (15). For clarification purposes, we propose to argue that the pressurized sensitive adhesive layer (19) is a component of the transfer mark layer (16). It is respectfully submitted that this clarification because Applicants are unsure what the Examiner means by stating that "a laminate of a pressured sensitive adhesive layer (19) and the transfer mark layer (16) can have adhesive forces", i.e. the pressured sensitive adhesive layer (19) is a constituent component of the transfer mark layer (16). In Figs. 5B, 5C and 6, the pressured sensitive adhesive layer (19) provides an adhesive force to the transfer area, i.e.,  $P_a = 19 / \text{transfer area}$  where the "/" represents the interface between the pressurized sensitive adhesive layer (19) and the transfer area. In Figs. 17B and 17C, the mark array layer (18) adheres to the base tape (15).

It is respectfully submitted that Figures 5B, 5C, and 6 clearly show "a pressured sensitive adhesive layer (19) to a base tape (15)" and Figures 17B and 17C clearly shown the mark array layer (18) adhered to the base tape (15)".

The second issue is whether there is a description in the disclosure explaining how the pressure sensitive adhesive layer which is laminated to a transfer mark layer can have adhesive forces to both the base tape and a transfer area at the same time. For clarification purposes, it is respectfully submitted that the pressure sensitive adhesive layer (19) is a constituent component of the transfer mark layer (16) and is therefore a single layer of the transfer mark layer (16). Assuming that Applicants correctly understand the Examiner's position, it appears that the Office Action asserts that the pressure sensitive adhesive layer (19) cannot have adhesive forces to both the base tape (15) and a transfer area at the same time.

Respectfully, the Examiner is referred to Figure 6. Figure 6 illustrates the mark transfer tape (T) been applied to a transfer area at the bottom of the drawing figure while, simultaneously, the mark transfer tape (T) is wrapped around a pay-out reel 11 at the top of the drawing figure. Since the mark transfer tape (T) is wrapped around the pay-out reel 11, the mark transfer tape (T) is also wrapped around itself. By way of example in Figures 5B and 5C, the pressure sensitive adhesive layer (19) having an adhesive force must be adhesively connected to the base tape (15) when the mark transfer tape (T) is wrapped around itself. Therefore, it is respectfully submitted that one of ordinary skill in the art would appreciate that the pressure sensitive adhesive layer can be adhesively connected to both the base tape and the transfer area at the same time.

The Office Action is also concerned of the geometry of the claimed invention as recited in claims 23, 24, 25, 27, 28 and 29.

The next issue with regard to claims 23 and 24 is whether the pressure sensitive adhesive layer is the layer holding a laminate to the base tape. As discussed above, it is respectfully submitted that the pressure sensitive adhesive layer holds the laminate to the base tape when the mark transfer tape is wrapped around itself.

The next issue with regard to claims 25 and 29 is whether the mark array layer is the layer holding a laminate to the base tape. As discussed above, it is

respectfully submitted that the mark array layer (18) is illustrated in Figures 17B and 17C as holding the laminate to the base tape (15).

The final issue with regard to claims 27 and 28 is whether a third layer, a surface forming layer of adhesive transparent material, is the layer holding the laminate to the base tape. As shown Figures 5B and 5C, it is respectfully submitted that the surface forming layer (17) is the layer holding the laminate to the base tape (15).

In summary, it is respectfully submitted that the sensitive adhesive layer (19) is a component of the transfer mark layer (16). That is, referring to embodiment 1 of the present application, for example, the transfer mark layer 16 is a laminated structure formed by laminating a surface forming layer 17, a mark array layer 18, and a pressure-sensitive adhesive layer 19 sequentially and integrally, namely, this laminate 16 (17, 18, 19) is prepared by laminating the surface forming layer 17, the mark array layer 18, and the pressure-sensitive adhesive layer 19 sequentially. However, when the transfer mark layer 16 as a laminate is once prepared, the transfer mark layer 16 behaves as an inseparable single layer and the sensitive adhesive layer 19 as a component of the transfer mark layer 16 also behave as a sensitive adhesive part of the transfer mark layer 16 without behaving as an independent single layer. This is apparent from Fig. 5C, Fig. 6, Fig. 10C, Fig. 11C, Fig. 16C, Fig. 17C, Fig. 18C, Fig. 19C and Fig. 20C, and the description in page 16, lines 6-16 of the specification "the drawing of the present application is intended to ease the understanding, and it is schematically magnified in the thickness direction." Actually, the thickness of the mark transfer tape T is like a thin film, and the boundary of layers is not as clear as shown in the drawing.

The specification is objected to because it discloses that  $PA \geq PB \geq PC \geq PD$  even though PB has different units. The specification is amended as indicated above to obviate the objection. Withdrawal of the objection is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe

anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

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Enclosure(s):       Amendment Transmittal  
                          Petition for Extension of Time (three months)

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